

Application No.: 10/591,456

REMARKS

The specification and claims stand objected to for minor informalities. It is respectfully submitted that the enclosed amendment obviates the alleged informalities. Accordingly, it is respectfully requested that these objections be withdrawn.

Claims 1 and 6 are independent and stand rejected under 35 U.S.C. § 102/103 over Chang '775 ("Chang"). These rejections are respectfully traversed for the following reasons.

Claim 1 recites in pertinent part, "a second insulating film formed so as to cover upper, lower and side surfaces of the first insulating film" (emphasis added). Claim 6 similarly recites in pertinent part, "wherein a lower surface of the first insulating film is covered with the second electrode and upper and side surfaces of the first insulating film are covered with a second insulating film" (emphasis added). According to one aspect of the present invention, the claimed combination can make it possible to suppress absorption of moisture and the like in the air by the first insulating film and dissipation of the charge from the first insulating film at heating (*see, e.g.*, paragraph 0012 of Applicants' specification).

In contrast, Chang merely discloses the conventional arrangement in which the alleged second insulating film 521 does not cover, *e.g.*, side surfaces of the alleged first insulating film 522 nor cover both upper and lower surfaces thereof. Only Applicants have recognized and considered the aforementioned effects, and conceived of the novel combination of elements configured such as to make it possible to realize said effects. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

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As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed, either expressly or inherently (noting that "inherency may not be established by probabilities or possibilities", *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999)), in a single prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the forgoing, it is submitted that the cited prior art does not anticipate claims 1, and 6, nor any claim dependent thereon.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as the independent claims are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

For example, the Examiner has discounted many features of the present invention by simply concluding obviousness based on Official Notice. Pursuant to MPEP § 2144.03, Applicants respectfully traverse the Examiner's taking of Official Notice and **request the Examiner to cite a reference which shows that the combination of claimed elements arranged in the manner embodied by the claims is well known** (see second paragraph, last three lines of MPEP § 2144.03, which requires the Examiner to cite a reference in support of his allegation of Official Notice when Applicants traverse). Indeed, only Applicants' specification discloses the claimed arrangement in the particular *combination* recited in the claims and the motivation therefor.

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Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. § 102/103 be withdrawn.

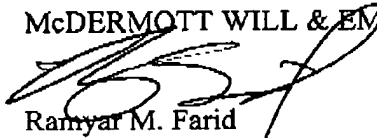
CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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